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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/599,690      | 06/22/2000  | Thomas J. Perkowski  | 100-035USA000       | 7979             |

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EXAMINER

BROWN, TIMOTHY M

ART UNIT PAPER NUMBER

1648

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                      |  |
|------------------------------|-----------------|----------------------|--|
| <b>Office Action Summary</b> | Application No. | Applicant(s)         |  |
|                              | 09/599,690      | PERKOWSKI, THOMAS J. |  |
|                              | Examiner        | Art Unit             |  |
|                              | Tim Brown       | 1648                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>October 17, 2003</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Final Office Action is responsive to Applicant's amendment and reply submitted October 17, 2003.

#### ***Oath/Declaration***

The declaration is objected to because the claim of priority under 35 U.S.C. § 120 improperly references application number 09/284,197. Application number 09/284,197 shares no common inventor with the present application. Appropriate correction is requested.

#### ***Terminal Disclaimer***

The terminal disclaimer mailed October 17, 2003 has been received. The processing of this terminal disclaimer is ongoing. It will be entered upon the determination that it complies with the relevant provisions of the MPEP. Accordingly, claims 7-12 are provisionally rejected under the doctrine of nonstatutory double patenting.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 7-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6 and 10 of U.S. Patent No. 5,918,214 (hereinafter "patent claims"). Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-6 are directed to an obvious embodiment of the patent claims.

The patent claims are directed to a system for using UPNs to access product information over the Internet. The system features a URL/UPN storage means for storing a plurality of URLs symbolically linked to a plurality of UPNs (see US 5,918,214 at col. 15, lines 57-64). Claims 1-6 relate to a system and method for generating and storing a plurality of URL/UPN data links. Because a URL/UPN data link must be generated before it can be recorded, it would have been obvious to develop the presently claimed means for generating URL/UPN data links.

### ***Claim Objections***

Claim 7 is objected to for failing to provide antecedent basis for "said second Internet-enabled information server" recited in line 12 of page 4 of Applicant's reply.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 7, 10-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudetz et al. (US 5,978,773 (hereinafter "Hudetz")).**

Regarding claim 7, Hudetz discloses an Internet based a product information management and delivery system comprising:

- a local relational database capable of storing UPNs, trademarks, product descriptors and URLs, wherein the local relational database is operatively connected to the Internet (Abstract, lines 4-6; col. 5, line 17);

- a data processing module having Internet browsing capabilities and CPIR function (Fig. 1, char. 30; Abstract, line 4; col. 12, lines 39-46);

- an electronic data transport apparatus capable of transmitting data including UPN information and trademarks (Abstract, lines 5-8);

- a first Internet server (Fig. 1, chars. 24 and 26; col. 5, lines 48-54);

- a second Internet database server<sup>1</sup> capable of receiving and processing requests from a client computer wherein said request may include UPN, trademark and product description data (col. 5, lines 48-54); and

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<sup>1</sup> It is assumed for purposes of examination that Applicant intended line 4, page 4 to recite "a second Internet-enabled database server."

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a Web-based computer capable of remotely managing data on said local relational database wherein the remotely managed data may include URLs, UPNs and product data (col. 12, lines 61-64).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz in view of Reisman (US 5,694,546).**

Hudetz teaches all the limitations discussed above. Hudetz does not expressly teach an EDI engine for importing data such as trademark and UPN information. However, Reisman teaches a server having an EDI gateway connection wherein the EDI gateway connects the server "to a large number of different merchant processors anywhere in the world." Col. 25, lines 21-27. At the time of Applicants' invention, it would have been obvious to an artisan of ordinary skill, to modify Hudetz to include Reisman's gateway server. As disclosed in Reisman, this would provide Hudetz with the ability to receive merchant information from merchants having varied network and hardware configurations.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

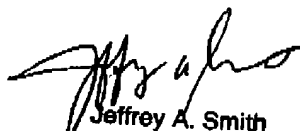
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Brown  
Examiner  
Art Unit 1648

tb



Jeffrey A. Smith  
Primary Examiner